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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/527,076

01/23/2006

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EXAMINER

SRIVASTAVA, KAILASH C

ART UNIT

PAPER NUMBER

1657

MAIL DATE

DELIVERY MODE

10/14/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/527,076	<b>Applicant(s)</b> KUSHMARO ET AL.	
	<b>Examiner</b> Dr. Kailash C. Srivastava	<b>Art Unit</b> 1657	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 09 March 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-19 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

1. Preliminary Amendment filed 09 March 2005 is acknowledged and entered.

### **General Non-Formal Matters**

2. Please note, the instant Non-Provisional application (i.e., 10/527,076) under prosecution at the United States Patent and Trademark Office (i.e., USPTO) has been assigned to Art Unit 1657. Please ensure, to aid in correlating any papers for the instant application (i.e., 10/527,076), all further correspondence regarding the instant application should be directed to Art Unit 1657.
3. The instant application (i.e., 10/527,076) has been assigned to Dr. Kailash C. Srivastava in the Art Unit 1657 at the USPTO. To aid in correlating any papers for the instant application (i.e., 10/527,076), all further correspondence regarding the instant application should be directed to Examiner Kailash C. Srivastava in Art Unit 1657.

### **Claims Status**

4. Claim 17 has currently been cancelled.
5. Claims 18-19 have currently been added
6. Claims 3-6, 9, 12 and 14-16 have currently been amended.
7. Claims 1-16 and 18-19 are currently pending.

### ***Election /Restriction***

8. This application contains the following groups of inventions, which are not so linked as to form a single general inventive concept under PCT Rule 13.1. Restriction to one of the following inventions is required under 35 U.S.C. §121 and §372.

- Group I, consisting of claims 1-6 and 18, drawn to a method to isolate a previously unculturable microorganisms;
- Group II, consisting of Claims 7-9 and 19 drawn to a microorganism/library of microorganism

- \Group III, consisting of claims 10-11, 13 and 15, drawn to a method to genomically characterize a bacterium.
- Group IV, consisting of Claims 12, 14 and 16 drawn to a microorganism.

***Inventions are Independent or Distinct***

9. The inventions listed as Groups I-II do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

The special technical features of each one of the inventive groups described *supra* is as follows:

- ❖ invention in groups I and II is a method to isolate a previously un-culturable bacterium and the bacterium itself;
- ❖ Groups III and IV invention is specific to genomically characterize an organism and the genomically characterized microorganism.

Thus, none of the inventions in Groups I-IV share the same or similar technical feature/ characteristics of invention in one of the other inventive groups. Furthermore, the steps in each of the two inventive methods (i.e., I and III) and components in each of the two inventive compositions (i.e., Groups II and IV) are entirely different than those applied for other (i.e., Group I inventive method and Group II composition). Additionally, the invention of each of Groups I-IV that of isolating/ characterizing a microorganism and the microorganism itself obtained by either two methods is already known in the prior art, e.g., by Fujishima et al (US Patent 5,744,325; Column 2, Lines 10-19 and Column 4, Lines 20-29) and Peterson et al (U.S. Patent 5,783,431; Column 16, Lines 19-42 and Column 16, Line 66 to Column 17, Line 20), either alone or in combination with the teachings from Fujishima et al.

The expression, “special Technical Feature” refers to those features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art. Thus, a feature found in the prior art can not be considered to be a special technical feature. Since no special technical feature exists among the inventions in groups I-IV, there is no unity of invention.

10. Restriction for examination purposes as indicated is proper because all the inventions listed in this action are independent or distinct for the reasons given above, and there would be a serious search and

examination burden if restriction were not required because one or more of the following reasons apply:

- a. the inventions have acquired a separate status in the art in view of their different classification;
- b. the inventions have acquired a separate status in the art due to their recognized divergent subject matter;
- c. the inventions require a different field of search (for example, searching different classes/subclasses or electronic resources, or employing different search queries);
- d. the prior art applicable to one invention would not likely be applicable to another invention;
- e. the inventions are likely to raise different non-prior art issues under 35 U.S.C. §101 and/or 35 U.S.C. §112, first paragraph.

**Applicants are advised that the reply to this requirement to be complete must include (i) an election of a invention to be examined even though the requirement may be traversed (37 C.F.R. §1.143) and (ii) identification of the claims encompassing the elected invention.**

11. The election of an invention may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse. Traversal must be presented at the time of election in order to be considered timely. Failure to timely traverse the requirement will result in the loss of right to petition under 37 C.F.R. §1.144. If claims are added after the election, applicant must indicate which of these claims are readable on the elected invention.

If claims are added after the election, applicant must indicate which of these claims are readable upon the elected invention.

Should applicants traverse on the ground that the inventions are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. §103(a) of the other invention.

12. Applicants are reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. §1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any

amendment of inventorship must be accompanied by a petition under 37 C.F.R. §1.48(b) and by the fee required under 37 C.F.R. §1.17(I).

13. The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims that depend from or otherwise include all the limitations of the allowable product claim will be rejoined in accordance with the provisions of M.P.E.P. § 821.04. **Process claims that depend from or otherwise include all the limitations of the patentable product** will be entered as a matter of right if the amendment is presented prior to final rejection or allowance, whichever is earlier. Amendments submitted after final rejection are governed by 37 C.F.R. §1.116; amendments submitted after allowance are governed by 37 C.F.R. §1.312.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 C.F.R. §1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. §101, §102, §103, and §112. Until an elected product claim is found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowed product claim will not be rejoined. See “Guidance on Treatment of Product and Process Claims in light of *In re Ochiai*, *In re Brouwer* and 35 U.S.C. § 103(b),” 1184 O.G. 86 (March 26, 1996). Additionally, in order to retain the right to rejoinder in accordance with the above policy, Applicant is advised that the process claims should be amended during prosecution either to maintain dependency on the product claims or to otherwise include the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.** Further, note that the prohibition against double patenting rejections of 35 U.S.C. §121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See M.P.E.P. §804.01.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Kailash C. Srivastava whose telephone number is (571) 272-0923. The examiner can normally be reached on Monday to Thursday from 7:30 A.M. to 6:00 P.M. (Eastern Standard or Daylight Savings Time).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Jon Weber can be reached at (571)-272-0925 Monday through Thursday 7:30 A.M. to 6:00 P.M. The fax phone number for the organization where this application or proceeding is assigned is (571)-273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding may be obtained from the Patent Application Information Retrieval (i.e., PAIR) system. Status information for the published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (i.e., EBC) at: (866)-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Dr. Kailash C Srivastava/  
Examiner, Art Unit 1657

Kailash C. Srivastava, Ph.D.  
Patent Examiner  
Art Unit 1657  
(571) 272-0923

29 September 2008  
/David M. Naff/  
Primary Examiner, Art Unit 1657